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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,122	08/18/2003	David H. Sprogis	5014CON	3473
55740 7590 01/15/2009 GAUTHIER & CONNORS, LLP 225 FRANKLIN STREET SUITE 2300 BOSTON, MA 02110				
EXAMINER				
CARLSON, JEFFREY D				
ART UNIT		PAPER NUMBER		
3622				
MAIL DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/643,122

Applicant(s)

SPROGIS, DAVID H.

Examiner

Jeffrey D. Carlson

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is responsive to the paper(s) filed 10/9/2008.

1. The affidavit filed on 10/9/2008 under 37 CFR 1.131 has been considered but is ineffective to overcome the Hunter reference.

Conception

2. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

- Applicant has provided essentially a list of dates for files and documents, but no copies or showing of facts regarding the content of those files. Examiner cannot verify conception without facts to demonstrate which **claimed features** were indeed possessed prior to the critical date. While applicant's appendices of file listings have been described as being *associated* with different portions of the specification and/or figures, no particular guidance has been provided demonstrating particular claimed features.

From MPEP 715.07 I: The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory

evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show.

...

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. **Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts"** and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). **Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established** and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (**Affidavit "asserts that facts exist but does not tell what they are or when they occurred."**).

Actual Reduction To Practice

Applicant states that "the system first became operational" on 3/17/2000, yet it is not clear what "the system" included? Where are the facts that demonstrate that all of the claimed features were present at this demonstration? It is noted that examiner could not access the referenced video at <http://www.cinecast.com/press/htm> [sic], nor at <http://www.cinecast.com/press.htm>, nor at <http://www.cinecast.com/press.html>. Although <http://www.cinecast.com/> was accessed and browsed, the referenced video was not located by the examiner from any of the links explored.

Therefore, it is not clear whether the claimed invention was ever actually reduced to practice on this or any other date, save for on a patent filing date.

Diligence

3. It is assumed that applicant did not reduce to practice the invention prior to the critical date of Hunter. Therefore applicant is assumed to be attempting to show prior conception coupled with due diligence until either a constructive reduction to practice or to an actual reduction to practice.

4. While diligence need not be addressed at this time, examiner finds at least the following concerns regarding diligence. This represents a cursory review of the diligence evidence and the examiner may find further faults with the diligence evidence when it is appropriate to analyze diligence in more detail (i.e. when conception has been properly shown).

MPEP 715.07(a): In determining the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958).

5. Again, applicant's evidence basically shows a collection of file listings and dates, but no particular facts regarding *activities* or the *subject matter* of any activities – and therefore diligence cannot be determined. Was the activity merely “related” to the subject matter? Or related to commercial exploitation? What was the activity that caused the files to be modified? Activities directly involved in a reduction to practice or to prepare the case for a patent application filing? Or trivial actions like file maintenance or spell checks?

From MPEP 2138.06: **An applicant must account for the entire period during which diligence is required.** *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA

Art Unit: 3622

1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). **A 2-day period lacking activity has been held to be fatal.** *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); *Fitzgerald v. Arbib*, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) **(Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice.** An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); *Kendall v. Searles*, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that applicants must be specific as to dates and facts.).

...

The work relied upon must be directed to attaining a reduction to practice of the subject matter of the counts. It is not sufficient that the activity relied on concerns related subject matter." *Gunn v. Bosch*, 181 USPQ 758, 761 (Bd. Pat. Inter. 1973)

Art Unit: 3622

6. Diligence must be shown to be "continuous".

From MPEP 715.07 III: applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference **continuously up to the date** of an actual reduction to practice or up to the date of filing his or her application (filing constitutes a constructive reduction to practice, 37 CFR 1.131).

From MPEP 715.07(a): An applicant may be diligent within the meaning of the patent law when he or she is doing nothing, if his or her lack of activity is excused. Note, however, that **the record must set forth an explanation or excuse for the inactivity**; the USPTO or courts will not speculate on possible explanations for delay or inactivity

7. Even with the questions regarding the file dates presented, there are substantial gaps in time that have not been accounted for. The following represent the largest gaps of unexplained time – smaller gaps are not necessarily "excused" gaps however.

Gap ending on	gap (days)
5/11/99	15
6/25/99	41
8/31/99	55
9/20/99	20
11/9/99	28
12/6/99	27
1/24/00	41
4/17/00	23
5/19/00	18
6/2/00	14
7/5/00	15

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 15-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 15-19 are system (apparatus) claims, yet they include many features which are presented as method steps rather than capabilities, rendering the claim scope uncertain. In these computer-based system claims, the best way to set forth apparatus structure is to claim *capabilities* of the apparatus by stating an element/module/subsystem is *programmed to <perform an act>* OR is *configured to <perform an act>*, rather than claiming the element actively performs the act. A claim covering both an apparatus and a method of using that apparatus is invalid because such a claim "is not sufficiently precise to provide competitors with an accurate determination of the 'metes and bounds' of protection involved" and is "ambiguous." MPEP 2173.05(p)(ii).
 - Claim 15 - schedule means further receives.
 - Claim 16 - schedule means further accesses.
 - Claim 17 - production means further assembles.
 - Claim 18 – projector assembly presents...and produces.
 - Claim 19 – logging means further receives...and generates.
- Applicant should make corrections similar to that made for claim 14.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 3-6, 8-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rabowsky (6,141,530) in view of Zigmond et al (6,698,020)

11. Regarding claims 1, 3-6, 8, 9, 11-19, Rabowsky discloses a system and method for providing advertisement information to an audience. In particular, Rabowsky teaches that cinema files are digitized and distributed to theaters electronically for playback. An automated scheduling system is provided in order to automatically play selected advertising with the actual timed movie showings [abstract, 1:61 to 2:5, 7:37-49, 12:8-29]. Rabowsky is taken to provide an enabling disclosure for compiling and assembling a presentation data package (ads + movie) at the headend. Rabowsky states the ability to request headend changes such as insertion of ads targeted to the theater location, yet it is not clear whether the targeted ads are manually or automatically selected and compiled. While Rabowsky teaches the ability to compile a collection of scheduled ads and the movie for each showing, he does not teach how and which particular ads are chosen for inclusion into the compiled presentation data package. While Rabowsky's movie advertising schedule is clearly automated in terms of playback, he lacks specific teachings for automating the selection of scheduled ads; it is unclear how the ads are chosen for inclusion in the schedule. Zigmond et al teaches

a system where video programming is provided with selected targeted advertising. Zigmond et al teaches that conventional prior art systems choose targeted ads based upon location [2:40-43] and that targeted ads can also be selected based upon the content of the video programming, location of the showing, characteristics of the viewer, local time, etc. and then subsequently displayed at the appropriate time [4:25-48]. This selection is accomplished by automatically comparing criteria (that has been entered/input and stored) regarding the audience, showing location and matching that with (input and stored) advertisement metadata/criteria representing the type of audience, type of location, etc. desired by each stored advertisement submitted by the advertiser [col 10-12]. This provides a system whereby job requests are submitted and the system automatically selects appropriately targeted ads for each movie showing. It would have been obvious to one of ordinary skill at the time of the invention to have created the advertising schedule of Rabowsky using similar techniques (matching stored context metadata concerning the movie content, its showing location, time, audience, etc., with stored metadata describing each stored advertisement) so that an appropriate subset of the advertisement collection can be associated and compiled with each actual movie showings. This would provide a more compelling advertisement experience likely to be more well received by the audience than untargeted ads, and would provide a system whereby administrators only need to specify targeting parameters/context/metadata rather than manually build each presentation data package for every movie showing. Regarding the particular collection of servers, subservers, WAN, LAN, etc, clearly the theaters and projectors of Rabowsky are

connected via networking to the central host. It would have been obvious to one of ordinary skill at the time of the invention to have provided any number of and configuration of servers, subnets, via WAN/LAN in order to provide an efficient and state of the art network capable of accepting job requests, downloading presentations and uploading result data. Rabowsky also teaches the concept of receiving feedback from the theater (i.e. the projectors) regarding a log of presentations (trailers) [7:38-42, 12:30-35].

12. Regarding claim 10, when the automated scheduling system creates a presentation (set of trailers) matched to the movie showing, it can be said that the system provides a means for determining whether the job request will be filled. Further, each of the finite collection of theater projectors and their finite collection of movie showtimes can only support a finite collection of trailers (assuming the desired duration for showing trailers is finite). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to have set limits for accepting advertising trailers for display and obvious to determine which job requests can be filled and which cannot.

13. Claims 2, 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rabowsky (6,141,530) in view of Zigmond et al (6,698,020) and Hunter (US6424998).

14. Regarding claims 2, 7, Hunter teaches remote distribution of advertising over a network to be displayed at screen locations, including locations inside a movie theater [abstract, 3:58-67]. Hunter further teaches that an advertiser uploads the advertising

content to a central host where a subset of the content is automatically selected for display on a remote screen location at a certain time. Importantly, Hunter teaches that the advertising is reviewed before security and appropriateness standards prior to being used by the server. It would have been obvious to one of ordinary skill at the time of the invention to have reviewed the advertising of Rabowsky in order to avoid inappropriate advertising content from being shown on the screens of Rabowsky.

Response to Arguments

15. Applicant's arguments filed 10/9/2008 have been fully considered but they are not persuasive.

16. Applicant argues that Hunter is not prior art under 102(e). As addressed above, the attempt to swear behind Hunter is ineffective; Hunter remains 102(e) prior art.

17. Applicant argues that because Rabowsky discloses its schedule of movies must be "authorized" [col 2 lines 2-3], the schedule of movies is not disclosed to be automated. To provide context, the portion relied upon in applicant's arguments includes:

an **automation/scheduling** system which **directs playback of cinema files** in the secure projector systems **as authorized by the management system** [col 1: line 67 to col 2: line 3].

This is the automated *playback* of the schedule that has already been created at the headend. The created schedule defines the cinema files to be shown. The cinema files are described here as "authorized" simply because they have been included in a schedule. Files/content not in the schedule are *not authorized* to be played. In other words the schedule itself *IS* the authorization. Nonetheless it is Rabowsky's above-

quoted "management system" which creates (read: authorizes) a schedule of cinema files to be played. The examiner essentially agrees that Rabowsky's scheduling process may not be an automated one – but not because Rabowsky's describes scheduled content as "authorized", but because there is not enough disclosure to be certain of any automation on the task of choosing cinema files to be part of the schedule. This is why the rejection is one of obviousness in view of Zigmond et al. It is also important to note that Rabowsky does clearly teach automated *autoplay* of that which is scheduled/authorized.

18. Applicant notes that Rabowsky allows for manual insertion of ads into a schedule, however this is not believed to be a proper teaching away from automating a schedule as suggested by Zigmond et al. In fact allowing for automation would be seen as an enhancement to Rabowsky rather than a "frustration of the principles of operation" as applicant argues. Indeed even an automated scheduling system could allow for manual changes or insertions; the two are not mutually exclusive.

19. Applicant argues that Zigmond et al does not teach a "schedule of ads", yet he classifies Zigmond et al as "selecting individual ads for specific time allocated spots in a programming feed" which sounds like a schedule of ads to the examiner. However, Examiner notes that Rabowsky already clearly has the desire for a schedule of ads, but is turning to Zigmond et al for teachings on how to automate *selection* of ads for scheduled playback. Applicant argues that "selecting individual ads for specific time allocated spots in a programming feed" is not the same as creating a schedule of targeted ads, which is a far more complex undertaking." The particular number of ads

to choose for a single advertising period is not seen as a terribly complex aspect, and is not seen as non-obvious or beyond one of ordinary skill.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/
Primary Examiner, Art Unit 3622

Jeffrey D. Carlson
Primary Examiner
Art Unit 3622